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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,698	07/09/2003	Andreas Lesche	GK-ZEI-3204 / 500343.2021	9745
7590	02/17/2004		EXAMINER	
Gerald H. Kiel, Esq. REED SMITH LLP 599 Lexington Avenue New York, NY 10022-7650			MARTINEZ, JOSEPH P	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,698

Applicant(s)

LESCHÉ, ANDREAS

Examiner

Joseph P. Martinez

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, claims 2-8 are rejected due to being dependent upon claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekine et al. (5572372).

Re claim 1, Sekine et al. teach for example, displaceable optics in microscope illumination, such as a displaceable collector, comprising: an outer guide sleeve (lens barrel 41, fig. 9A); a cylindrical optics housing (optical system holding member 51, fig. 9A) which slides in the guide sleeve; and Teflon being provided between the optics housing and guide sleeve (col. 5, ln. 39-44) for flexible centering of the optics, but fail to implicitly teach the Teflon in the form of strips. However, the office interprets the teachings of Sekine et al. wherein Sekine et al. discloses the use of an "iron piece adhesively secured to the outer peripheral surface of the optical system holding member 51 and the surface thereof may be Teflon-worked to make it

Art Unit: 2873

readily slidable” (col. 5, ln. 39-44) to disclose the use of Teflon in any manner to facilitate sliding, including the use of Teflon in the form of strips. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Teflon in the form of strips for ease of manufacturing.

Re claims 2-5 and 8, Sekine et al. further teach for example, displaceable optics as disclosed above, including the use of Teflon, but fail to implicitly teach Teflon strips arranged in parallel to the displacing direction of the optics housing, provided in pairs opposite one another, wherein an odd or even quantity of Teflon strips are uniformly distributed over the circumference of the optics housing, wherein the Teflon strips are provided at 120 degree offset relative to one another with respect to the circumference or wherein the Teflon strips are glued on. However, the office interprets the teachings of Sekine et al. wherein Sekine et al. discloses the use of an “iron piece adhesively secured to the outer peripheral surface of the optical system holding member 51 and the surface thereof may be Teflon-worked to make it readily slidable” (col. 5, ln. 39-44) to disclose the use of Teflon in any manner to facilitate sliding, including the use of Teflon in the form of strips glued and situated in various manners. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Teflon in the form of strips for ease of manufacturing.

Re claims 6-7, Sekine et al. further teach for example, the Teflon is arranged at the guide sleeve and at the optics housing (col. 5, ln. 39-44, wherein the office interprets the Teflon to be at the point where the optical system holding member 51 and fixed portion 42 interact and therefore meet the claimed limitations).

Conclusion

Art Unit: 2873

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Imanari et al. (5657173) teach the use of Teflon between a fixed and moveable portion (fig. 2, col. 3, ln. 66-67 to col. 4, ln. 1-4).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph P. Martinez whose telephone number is 571-272-2335. The examiner can normally be reached on M-F 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4883.

JPM
1-23-04



Hung Xuan Dang
Primary Examiner